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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,320	01/26/2001	Adam L. Schwartz	LGC-129	6708

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LUMEN INTELLECTUAL PROPERTY SERVICES, INC.
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EXAMINER

MEHRPOUR, NAGHMEH

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,034

Applicant(s)

GRIESWALD, JENS

Examiner

Shick C Hom

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/28/01, 3/25/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2666

DETAILED ACTION

Drawings

1. The drawings are objected to because in Figs. 1-2 and 4-6 as brief descriptive label must be provided for each of the numbered boxes, e.g. in Fig. 1, provide labels for Application 10a, 10b; systems 12a, 12b; transmission medium 14; and transit system 16; in Fig. 2, provide labels for users 18a, 18b; in Fig. 4, provide labels for systems 12a, 12b; protocol tester 22; transit system 16; in Fig. 5, provide labels for lines 26a, 26b; in Fig. 6, provide labels for test apparatus 28, and ports 32a-32d. In Fig. 3, number blocks 20a-c as recited in page 4 line 21 of the specification. In Fig. 5, provide number for port 23 as recited in page 6 line 15 of the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: in page 2 line 18 delete "a use 18a, 18b" and insert ---a user 18a, 18b---.

Appropriate correction is required.

Art Unit: 2666

Claim Objections

3. Claims 1-10 are objected to because of the following informalities: in claim 1 lines 2-3 and claim 6 line 5, the words "a higher layer" seems to refer back to "a higher layer" recited in claim 1 line 2 and claim 6 line 5, respectively. If this is true, it is suggested changing "a higher layer" to ---the higher layer---. In claim 1 line 4 and claim 6 line 7, the words "a communication" seem to refer back to "a communication" recited in claim 1 line 1 and claim 6 lines 3-4, respectively. If this is true, it is suggested changing "a communication" to ---said communication---. In claim 8 line 1, delete typo "claims 7 or 8" and insert ---claims 6 or 7---. In claim 9 line 1 delete typo "claim 9" and insert ---claim 8---. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 lines 4-5 and claim 6 line 7, which recite "a layer" is not clear as to whether it is reciting ---the higher

Art Unit: 2666

layer--- of claim 1 lines 2-3 and claim 6 line 5, respectively, or some other layer. Claim 7 line 2 which recite "the data" lack clear antecedent basis because no data have been previously recited in the claims and therefore the limitation is not clearly understood. Claim 8 line 1, which recite "the input data" lack clear antecedent basis. Claims 2-5 and 9-10 are rejected under 35 U.S.C. 112, second paragraph because they depend from rejected claims 1 and 6, respectively.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 and 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Autrey et al. (5,774,695).

Regarding claim 1:

Autrey et al. disclose the circuit arrangement with which a communication that is subdivided into functional layers is processable by a first layer for a higher layer and/or by a higher layer for the first layer, the first layer being formed

Art Unit: 2666

by a physical layer (see col. 1 lines 35-67), comprising at least one port which allows a communication directly with a layer that is higher than the first layer without the communication previously having to pass through the first layer (see col. 4 line 56 to col. 5 line 3 and col. 5 lines 33-40).

Regarding claim 2:

Autrey et al. disclose wherein the functional layers correspond to an OSI reference model (see the OSI model in col. 1 lines 35-67).

Regarding claim 3:

Autrey et al. disclose wherein the communication comprises the step of inputting data into the at least one port and/or outputting data from the at least one port (see col. 5 lines 3-40 and col. 6 lines 41-45).

Regarding claim 6:

Autrey et al. disclose the method for testing a switch for a telecommunication network comprising the steps of: providing the switch with a circuit arrangement with which a communication that is subdivided into functional layers is processable by a first layer for a higher layer and/or by a higher layer for the first layer, the first layer being formed by a physical layer (see col. 1 lines 35-67) and the circuit arrangement featuring at least one port which allows a communication directly with a

Art Unit: 2666

layer that is higher than the first layer without the communication previously having to pass through the first layer (see col. 4 line 56 to col. 5 line 3); outputting data from the at least one port (see col. 5 lines 33-40); and analyzing of the output data (see col. 2 lines 1-13).

Regarding claim 7:

Autrey et al. disclose the step of inputting the data into the at least one port before the outputting step (see col. 5 lines 33-40).

Regarding claim 8:

Autrey et al. disclose wherein the input data comprise a stimulation signal (see col. 7 lines 31-38 and col. 12 lines 10-20).

Regarding claim 9:

Autrey et al. disclose wherein the output data comprise a response to the stimulation signal (col. 7 lines 31-38 and col. 12 lines 10-20).

Regarding claim 10:

Autrey et al. disclose wherein the output data comprise a monitoring signal (see col. 12 lines 3-32).

Art Unit: 2666

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Autrey et al. (5,774,695) in view of Warren (6,381,721).

For claims 4 and 5, Autrey et al. disclose the circuit arrangement described in paragraph 6 of this office action. For claims 4 and 5, Autrey et al. disclose all the subject matter of the claimed invention with the exception of wherein the processing of the communication is realized on a single chip, with the port being provided on the chip as recited in claim 4 and wherein the processing of the communication is realized on a first chip and the port on a second chip, the first and second chips being linked with each other for data transfer as recited in claim 5.

Art Unit: 2666

Warren from the same or similar fields of endeavor teach that it is known to provide the processing of the communication is realized on a single chip, with the port being provided on the chip (see col. 1 lines 55-67) and wherein the processing of the communication is realized on a first chip and the port on a second chip, the first and second chips being linked with each other for data transfer (see col. 3 line 43 to col. 4 line 16 and the first and second chip in claim 9). Thus, it would have been obvious to the person having ordinary skill in the art at the time the invention was made to provide the processing of the communication being realized on a single chip, with the port being provided on the chip and the processing of the communication being realized on a first chip and the port on a second chip, the first and second chips being linked with each other for data transfer as taught by Warren in the circuit arrangement of Autrey et al. The motivation for providing the processing of the communication being realized on a single chip, with the port being provided on the chip and the processing of the communication being realized on a first chip and the port on a second chip, the first and second chips being linked with each other for data transfer as taught by Warren in the circuit arrangement of Autrey et al. being that it provides desirable

Art Unit: 2666

added feature of integrated circuit technology to the circuit arrangement of Autrey et al.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gessel et al. disclose a system and method of testing open systems interconnection (OSI) layers in telecommunication networks.

10. Any response to this nonfinal action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (2600 Receptionist at (703) 305-4750).

Art Unit: 2666

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shick Hom whose telephone number is (703) 305-4742. The examiner's regular work schedule is Monday to Friday from 8:00 am to 5:30 pm EST and out of office on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao, can be reached at (703) 308-5463.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


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TECHNOLOGY CENTER

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February 6, 2004